

7/23/02

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Paper No. 12
DEB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Florida Family Insurance Services, LLC

Serial No. 75/877,976

Paul E. Schaafsma and Joseph M. Talarico of Foley and
Lardner for Florida Family Insurance Services, LLC.

Jeremy M. Klass, Trademark Examining Attorney, Law Office
108 (David Shallant, Managing Attorney).

Before Cissel, Walters and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Florida Family Insurance Services, LLC sought to
register the term BIG RE INTERMEDIARIES on the Principal
Register in conjunction with services recited, as amended,
as "insurance services, namely, the brokering of
reinsurance," in International Class 36.¹

Registration was finally refused pursuant to Section
2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on

¹ Application Serial No. 75/877,976 was filed on December 22,
1999 based upon applicant's allegation of a *bona fide* intention
to use the mark in commerce under Section 1(b) of the Act.
Absent any subsequent allegation of use, this application remains
an intent-to-use application.

the ground that applicant's mark is merely descriptive of its services.

Applicant filed this appeal, but did not request an oral hearing before the Board. Both applicant and the Trademark Examining Attorney have fully briefed the case.

We affirm the refusal to register.

The test for determining whether a mark is merely descriptive is whether the term immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or is intended to be used. In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979); In re Engineering Systems Corp., 2 USPQ2d 1075 (TTAB 1986). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods, only that it describe a single, significant quality, feature, etc. In re Venture Lending Associates, 226 USPQ 285 (TTAB 1985). Further, it is well established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the services in connection with which registration is sought, the context in which the mark is used, or is intended to be used, and the impact that it is likely to

make on the average purchaser of such goods or services.

In re Recovery, 196 USPQ 830 (TTAB 1977).

We must consider the issue of descriptiveness before us in relation to the services identified in the instant application, i.e., reinsurance brokerage services. While we must consider the mark in its entirety, it is permissible, as argued by the Trademark Examining Attorney, to focus sequentially on the various components of a composite mark to understand what its overall connotation will be to members of the relevant public.

The record herein makes it clear that the term "RE" has gained wide acceptance in the insurance industry as a shortened form of "Reinsurance."² Equally clear from the Lexis/Nexis excerpts submitted by the Trademark Examining Attorney is the fact that reinsurance brokers, such as applicant, often function as "intermediaries" between the reinsurance companies and the ceding³ insurance company:

"YDJ Reinsurance Intermediaries LLC, a reinsurance brokerage firm..." (A.M. Best Company, Nov. 17, 2000), and

² From the Lexis/Nexis excerpts placed into the record by the Trademark Examining Attorney, we see trade names for insurance intermediaries, such as Sten-Re, American Re, North American Re, U.S. Re Corp., Inter-Ocean Re, Aon Re Worldwide, Sedgwick Re, WinterBrook Re Intermediaries, Trenwick American Re, Alexander Re, Munich Re, Zurich Centre Re Group-U.S., Allmerica Re division of Hanover, IPC Re, USF Re, Crump Re and Magnant Re.

³ To "Cede" is to transfer to a reinsurer all or part of the insurance or reinsurance risk written by a ceding company.

"Aside from employing brokers, reinsurance intermediaries today now hire lawyers, mathematicians..." (Business Insurance, Nov. 10, 1997). Accordingly, we find that "RE INTERMEDIARIES" is a highly descriptive term for reinsurance brokers such as applicant, and for the services that such firms provide.

As to the word "big," classified within the category of merely descriptive designations are those expressions that Professor McCarthy refers to as "puffing" or "self-laudatory terms."⁴ As noted by the Trademark Examining Attorney, words like "big" are commonly used in trademarks and service marks as a laudatory term. However, a term indicating nothing but high quality or large size surely cannot function inherently as an indicative of origin to the purchasing public. See In re Bush Bros. & Co. 884 F.2d 569, 12 USPQ2d 1058 (Fed. Cir. 1989) [DELUXE]; Exquisite Form Industries, Inc. v. Exquisite Fabrics of London, 378 F.Supp. 403, 183 USPQ 666 (S.D.N.Y. 1974) [EXQUISITE]; In re Consolidated Cigar Co., 35 USPQ2d 1290 (TTAB 1995) [SUPER BUY]; In re Ervin, 1 USPQ2d 1665 (TTAB 1986) [THE ORIGINAL]; In re Inter-State Oil Co., 219 USPQ 1229 (TTAB 1983) [PREFERRED]; In re Royal Viking Line A/S, 216 USPQ

⁴ 2 J. McCarthy, McCarthy on Trademarks & Unfair Competition, § 11.17 (4th ed. 2001).

795 (TTAB 1982) [WORLD CLASS]; and In re Wileswood, Inc.,
201 USPQ 400 (TTAB 1978) [AMERICA'S BEST POPCORN! and
AMERICA'S FAVORITE POPCORN!]. Each of the expressions from
these reported decisions indicate that the objects to which
they are applied stand out preeminently above the class to
which they belong by reason of some outstanding achievement
or quality. This is especially relevant when the word
"big" is used in this particular business inasmuch as
several of the Lexis/Nexis excerpts suggest that ongoing
industry consolidation has resulted in increasingly large,
global megabrokers:

... Over the past 12 months, such household
names ... have been lost in the consolidation
frenzy... At the same time, other reinsurance
brokers also have joined forces to form new
global players... As brokers still sort out
the effects of consolidation, they agree
that the merger and acquisition movement is
not over yet... "New Brokers Debut in Top 10:
Consolidations Form Dominant Global
Players," Business Insurance, November 10,
1997.

... The reinsurance intermediaries in the
United States number around 90 firms, with
that number drastically reduced when we are
talking about reinsurance brokers that are
capable of brokering a complete reinsurance
program for a property and casualty company...
The top 10 reinsurance intermediaries in the
United States have certain general
characteristics... "Small, Medium-Sized
Brokers Losing Independence," National
Underwriter, June 19, 1989.

Hence, based upon this record, we find that when the laudatory term BIG is placed directly in front of the highly descriptive designation, RE INTERMEDIARIES, applicant's claimed service mark immediately conveys information concerning characteristics or attributes of applicant's reinsurance brokerage services, namely, that applicant purports to be a big reinsurance broker, which functions as an intermediary between the reinsurance underwriting company and the ceding insurance company.⁵

Applicant argues that the Trademark Examining Attorney has improperly dissected the composite mark. In the event that the combined term, "BIG RE," for example, were to have another specific connotation, it might be possible for the entire composite herein to take on another meaning. However, nowhere has applicant identified any alternative, non-descriptive meaning for this combined term, "BIG RE." Hence, we find that the entire term BIG RE INTERMEDIARIES is merely descriptive of the recited services.

Decision: The refusal to register is affirmed.

⁵ There is nothing in the record indicating whether or not applicant's assets and transactions would qualify it for inclusion in the class of the behemoths in the industry. In any case, whether a megabroker or not, Section 2(e)(1) precludes registration of this matter to applicant as being either merely descriptive, or in the alternative, as being deceptively misdescriptive.